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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,676	02/22/2005	Terje Skaug	915-001.036	2315

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EXAMINER

KARIM L PEGEMAN

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

09/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/501,676	Applicant(s) SKAUG, TERJE
Examiner PEGEMAN KARIMI	Art Unit 2629

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6 and 10-14.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Chanh Nguyen/
Supervisory Patent Examiner, Art Unit 2629

/Pegeman Karimi/
Examiner, Art Unit 2629

Continuation of 11, does NOT place the application in condition for allowance because:

Applicant argues that the cited references at least fail to disclose or suggest that "the pointing device is configured to operate independent of a functionality of the existing electronic device"

a) it would not have been obvious to one of ordinary skilled in the art to achieve as a result the solution disclosed by claim 1 by adding the remote control system of Steele to the telephone main body of Miyashita because such a device could not be for multiple usage as a telephone and cursor pointing device. Wherein the applicant further argues that if the remote control system of Steele were added to the telephone set main body of Miyashita, the main function of the already existing device is to act as the pointing device and the already existing device is not able to act as a mobile telephone.

Examiner respectfully disagrees with the applicant because the remote control system of Steele can be added to the portable telephone set body 100 of Miyashita wherein the user can use the device 100 primarily as a telephone and also use the device 100 as a pointing device by using the added functionality of remote control system 400a. The user may use the device as a telephone or use the device as an auxiliary device such as a pointing device wherein the device 400a can be attached to the portable device and the user can use the portable device 100 as a pointing device by pointing a cursor on an external display device.

By adding the remote control system of 400a to the portable mobile device of 100 a user can independently use the portable device as a telephone or can independently use the device as a pointing device.

Applicant argues that Lee teaches away from the idea of the invention, since according to the invention performing the auxiliary function does not exclude the simultaneous operation of the main function. Examiner would like to point out that in the limitation of "the pointing device is configured to operate independent of a functionality of the existing electronic device" the applicant does not mention the user can use both the telephone and the pointing device simultaneously and also does not mention the user does not use the same parts or buttons of the telephone device in order to use the pointing device. In the prior art reference of Miyashita it can be interpreted that the user uses the pointing device 105 independently without using the functions such as dialing a number or calling before using the pointing device. The user is using the auxiliary device by using the pointing device 105's buttons such as 107-109 and cable 171. When the user is using the telephone device the user is using the keypad 112 placed on the electrodes 127 and the speaker holes 110 and 114 therefore using the telephone independent of the pointing device 105A's buttons such as 107-109 and the user can use the portable telephone set 100 as an auxiliary device for pointing purposes.

Applicant also argues that it would not be obvious for one of skill in the art to combine the device of Lee with the devices of Miyashita and Steele to arrive at the limitations recited in claim 1.

As was mentioned above the prior art references of Miyashita and Steele teach the functionality of a telephone device and an auxiliary device such a pointing device combined in a portable telephone set. The two devices work independently from each, however, in order to show this functionality in better detail the prior art reference of Lee has been added, which teaches a laser pointer can be installed in the main body of the mouse. This laser pointer is controlled by the control switch therefore one skilled in the art may add the laser emitter of Lee to the mouse section 105 of Miyashita in order for the portable telephone set to have an auxiliary function of pointing device. Since the laser projection is independent from the portable telephone set therefore the limitation of "the pointing device is configured to operate independent of a functionality of the existing electronic device" is met.